

Appl. No. : **10/733,878**
Filed : **December 10, 2003**

REMARKS

In the Restriction Requirement mailed December 15, 2005, the Examiner alleges that the currently pending claim set is divisible into 278 different claim groups. This response addresses the claims of Groups I-LXVIII, which are each classified in class 536, subclass 23.1 or class 530, subclass 350.

In response to this Restriction Requirement, Applicants provisionally elect the claims of Group VII (claims 2, 4 and 5-19) with traverse. Applicants also elect the species "encodes a polypeptide involved in inflammatory disease." Although the claims in Groups I-LXVIII are patentably distinct, as described further below, Applicants submit that the claims of these groups can be searched and examined together without serious burden.

At page 29 of the instant Restriction Requirement, the Examiner states that claims 1 and 3 link the claims of Groups I-VIII, claims 20 and 22 link the claims of Groups IX-XX and claim 38 links the claims of Groups XXI-LXVIII. The Examiner also states that "[u]pon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application." Applicants note that, according to section 809 of the M.P.E.P., "the linking claims must be examined with the invention elected." Although the Examiner treats claim Groups I-LXVIII under linking claim practice, Applicants submit that claims 1 and 3 are also generic for claim groups I-VIII, claims 20 and 22 are also generic for the claims of Groups IX-XX and that claim 38 is also generic for the claims of Groups XXI-LXVIII. In order to clearly explain their position that all of the claims of Groups I-LXVIII can be searched and examined together without serious burden, Applicants will focus their argument on the relationship between the broadest generic claim of Groups I-VIII (claim 1), Groups IX-XX (claim 20) and Groups XXI-LXVIII (claim 38).

Before discussing the relationship between the claims of the restricted groups, however, Applicants believe that it would be beneficial to briefly describe their discovery of certain THAP-family polypeptide amino acid sequence domains and the role of these domains in gene expression. In particular, Applicants were the first to discover that THAP-family polypeptides (for example, THAP0 and THAP1 – THAP11) include amino acid sequence domains that have particular functions. Some of these domains permit interaction with a protein binding partner

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(for example, binding with a chemokine, PAR4 or another THAP-family monomer). One of the domains, which Applicants termed the THAP domain, interacts with nucleic acids at certain recognition sequences, thereby either enhancing or repressing the expression of a THAP responsive gene. THAP-family polypeptides may mediate their effects on THAP responsive gene expression both when they are bound to a protein binding partner (e.g., a chemokine) as well as when they are not bound to a binding partner. In view of this discovery regarding the involvement of THAP-family polypeptide domains in gene expression, Applicants have filed the instant application.

Applicants request that the Examiner search and examine the claims of Groups I-LXVIII (claims 1-58) together. Section 803 of the M.P.E.P. states that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” As stated above, although Groups I-LXVII are patentably distinct, Applicants respectfully submit that these groups can be searched and examined together without serious burden because they are all directed to similar, significantly overlapping subject matter. In particular, the claims of Groups I-LXVIII are all drawn to methods of modulating the expression of a gene that is responsive a THAP-family polypeptide. Furthermore, the generic claims linking claims 1, 20 and 38 are drawn to methods of modulating expression of a THAP responsive gene. Claim 1 comprises modulating the interaction of a THAP-family polypeptide of a biologically active fragment thereof with a nucleic acid so as to enhance or repress the expression of the THAP responsive gene. In claims 20 and 38, the expression of a gene responsive a THAP/chemokine complex is enhanced or repressed either by modulating the interaction of the THAP/chemokine complex with a nucleic acid (claim 38) or by modulating the interaction between a THAP-family polypeptide or biologically active fragment thereof with a chemokine (claim 20). Applicants have provisionally elected that the Examiner search and examine the claims of Group VII. In order to assess the patentability of the claims of Group VII, the Examiner must also assess the patentability of generic linking claim 1 (see, M.P.E.P., section 809). To adequately assess the patentability of generic claim 1, the Examiner must search for prior art that describes both methods of enhancing and methods of repressing gene expression by modulating the interaction between a nucleic acid and a THAP-family polypeptide, wherein the THAP-

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family polypeptide is either bound or unbound to a protein binding partner, such as a chemokine. As a result, searching the entire scope of claim 1 would reveal the art relevant to the patentability of generic linking claims 20 and 38 (related to THAP/chemokine complexes). This result is also evidenced by the fact that the claims of Groups I-LXVIII are all in the same search class and subclass (see the Examiner's classification above). Accordingly, a search for the subject matter of the claims of Group VII would also encompass the search for the subject matter of the claims of Groups I-VI and VIII-LXVIII.

Because Groups I-LXVIII contain significantly overlapping subject matter and because they are classified in the same search class and subclass, an undue burden would not be placed on the Examiner if claim Groups I-LXVIII were searched and examined together. As such, Applicants respectfully request partial withdrawal of the Restriction Requirement, and examination of claim Groups I-LXVIII (claims 1-58) on the merits.

CONCLUSION

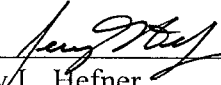
Applicants believe that all outstanding issues in this case have been resolved and that the present claims are in condition for allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is invited to contact the undersigned at the telephone number provided below in order to expedite the resolution of such issues.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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